

REMARKS

It is submitted that the subject application was filed June 8, 2006, such that the filing date indicated on the Official Action requires correction.

Claims 12-22 have been amended, and new claims 23-24 have been added.

Claims 12-24 are presently pending.

The specification has been amended to correct typographical errors uncovered during further review of the application.

Claim 19 has been amended to correct the typographical error noted by the Examiner, such that the objection to claim 19 should be withdrawn.

Claim 16 has been amended to clarify that "2-components PU" means --a two component polyurethane--. (See substitute specification at page 2, second paragraph, and page 4, third paragraph.). Accordingly, the Examiner's rejection of claim 16 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

In view of such amendments and the following remarks, reconsideration and allowance of the claims, as presently presented, are respectfully requested.

EXAMINER'S ACTION

The 35 U.S.C. § 102 Rejections

Claims 12-18 were rejected as being anticipated by U.S. Patent No. 4,496,475 ("Abrams") or U.S. Patent No. 6,436,159 ("Safta et al."). In addition, claim 12 was rejected as being anticipated by U.S. Patent Publication No. 2004/0058147 ("Ozawa et al.").

Claims 12-18 have been amended to clarify that the invention is directed to a "floor" surface covering. Amended independent claim 12, and claims 13-18 and new

claims 23-24 which depend directly or indirectly from claim 12, clearly are patentable over each of the cited references.

Claim 12 is directed to a floor surface covering comprising a substrate and a top coating, where the top coating comprises between 0.01 and 10% w/w of particles with a conductive coating having a mean size between 0.1 and 50 μm , based on the weight of the top coating. Advantageously, the floor surface covering of the claimed invention does not significantly increase the electrical resistance of the flooring while providing that the top coating is transparent and easily cleaned and maintained. (See substitute specification at page 3, lines 17-23).

Abrams, which concerns a conductive paste for application to electronic component substrates, such as capacitors and dielectric components (Col. 3, In. 24-35), is non-analogous prior art, because it does not disclose or concern a "floor" surface covering as recited in claim 12.

As to *Safta et al.*, although this reference concerns coatings for floor coverings, the coating composition that is disclosed does not include particles with a conductive coating. The "macrocrystalline or single mineral abrasive component" of the *Safta et al.* coating composition is made from aluminum oxide or silicon dioxide (Col. 4, In. 1), which are insulators, and, therefore, do not constitute particles with a conductive coating contained in a top coating, as required by amended claim 12.

Ozawa et al., which concerns an antistatic film for space applications (see paragraph [0002]), also clearly does not disclose or concern a "floor" surface covering, as required by amended claim 12.

Accordingly, claim 12 is patentable over each of *Abrams*, *Safta et al.* and *Ozawa et al.*

Further, claims 13-18 and 23-24, which depend directly or indirectly from claim 12, are also patentable over each of Abrams, Safta *et al.* and Ozawa *et al.* for the same reasons as set forth above with respect to claim 12 and because of the further restrictions they add.

The 35 U.S.C. § 103 Rejections

The Examiner rejected claims 13-14 and 18-22 as being obvious over Safta *et al.* in view of U.S. Patent No. 5,626,948 ("Ferber *et al.*").

It is respectfully submitted that, contrary to the Examiner's statement, Ferber *et al.* is not in "the same filed [sic., field] of endeavor" as the subject claimed invention. Referring to Ferber *et al.*, this reference concerns conductive compositions for use as part of an electrical system on the surface of a substrate (Col. 2, In. 14-17) and, in particular, for providing an electrical current path between a power source and a current operated component on a substrate. Clearly, one skilled in the art of floor surface coverings would not have considered Ferber *et al.*. Furthermore, Ferber *et al.* does not cure the deficiencies of Safta *et al.* with respect to the lack of a teaching or suggestion of including particles with a conductive coating in a top coating, as required by claim 12 and claims 13-14 and 18-22, which depend from claim 12.

Accordingly, claims 13-14 and 18-22 are patentable over the cited reference combination.

Withdrawal of the Section 102 and 103 rejections is, therefore, respectfully requested.

CONCLUSION

For the foregoing reasons, it is believed that all of the claims, as presently presented, are patentable.

The Examiner is invited to telephone the undersigned if it is believed that further amendment and/or discussion would help to advance the prosecution of the present application.

Reconsideration and allowance of claims 12-24 are, therefore, respectfully requested.

Respectfully submitted,



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